UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,718	01/29/2004	Thomas Stephan	10022-398	8528

28164   7590   03/25/2008
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EXAMINER
WONG, ERIC TAK WAI

ART UNIT	PAPER NUMBER
3693	

MAIL DATE	DELIVERY MODE
03/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/769,718	STEPHAN ET AL.
Office Action Summary	Examiner	Art Unit	
	ERIC WONG	3693	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 January 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-32 are pending. The following is a non-final first Office action on the merits of

claims 1-32.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Examiner's note: Examiner has pointed out particular references contained in the prior art of record in
the body of this action for the convenience of the Applicant. Although the specified citations are
representative of the teachings in the art and are applied to the specific limitations within the individual
claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully
the **entire** reference as potentially teaching all or part of the claimed invention, as well as the content of
the passage as taught by the prior art or disclosed by the Examiner.

2.   Claims 1, 5, 6, 10, 11, 14, 17, 21, 22, 26, 27, and 30 rejected under 35 U.S.C. 103(a) as

being unpatentable over Cavanah ("Consultant in a Box") in view of Englemen et al. (US Patent

Application Pub. No. US-2003/0163357 A1)

3.   Regarding claims 1 and 17,

Cavanah teaches collecting responses from an industry expert to evaluation questions,

inputting said responses into a computer analysis tool, analyzing said responses to said

evaluation questions using said computer analysis tool, and reporting a computer generated

analysis to said industry expert contemporaneously with said interviewing step, said inputting

step and said analyzing step, wherein immediate results are provided to said industry expert

and wherein scenarios of said responses are immediately comparable (see page 2).

Cavanah does not teach collecting a weighting determined by said industry expert of an evaluation category and analyzing said responses to said evaluation questions in response to said weighting of said evaluation category. Englemen et al. teaches determining a weighting of requirement attributes associated with an evaluation category and analyzing responses in response to said weighting (see paragraphs [0047] through [0050]).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the automated consulting system of Cavanah with collecting a weighting determined by said industry expert of an evaluation category and analyzing said responses to said evaluation questions in response to said weighting of said evaluation category as taught by Englemen et al. One skilled in the art would have been motivated to make the modification for the benefit of better satisfying the goals of the company.

4.   Regarding claims 5 and 21,

Englemen et al., not Cavanah, teaches predetermined weightings of said evaluation questions are changeable in response to a determination by said industry expert (see paragraphs [0047] through [0050]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Cavanah further with predetermined weightings of said evaluation questions being changeable in response to a determination by said industry expert as taught by Englemen et al. One skilled in the art would have been motivated to make the modification for the benefit of better targeting the goals of the company.

5.   Regarding claims 6 and 22,

Englemen et al., not Cavanah, teaches a computer generated analysis comparing said responses to said evaluation questions to said weighting of said evaluation category (see [0049]).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Cavanah further with a computer generated analysis comparing said responses to said evaluation questions to said weighting of said evaluation category as taught by Englemen et al. One skilled in the art would have been motivated to make the modification for the benefit of incorporating the relative importance of each function under review at the company.

6.   Regarding claims 10 and 26,

Cavanah teaches collecting responses from said industry expert to benchmarking questions, wherein said benchmarking questions cluster and segment a company of said industry expert (see page 2 paragraph 2).

7.   Regarding claims 11 and 27,

Englemen et al., not Cavanah, teaches wherein said evaluation categories comprise categories of value chain steps and performance attributes and wherein said evaluation questions comprise groups of questions organized within each of said value chain steps (see paragraphs [0047] through [0050]). Examiner notes that "Executive Questions" in the reference are performance attributes whereas "functions under review" in the reference are the value chain steps. Englemen et al. further teaches wherein said weighting comprises a weighting determined by said industry expert for each of said value chain steps and said performance attributes; and wherein said computer generated analysis comprises separate analyses for each

of said value chain steps and said performance attributes (see paragraphs [0047] through [0050]).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the automated consulting system of Cavanah with said evaluation categories comprising categories of value chain steps and performance attributes and said evaluation questions comprising groups of questions organized within each of said value chain steps; wherein said weighting comprises a weighting determined by said industry expert for each of said value chain steps and said performance attributes; wherein said weighting comprises a weighting determined by said industry expert for each of said value chain steps and said performance attributes; and wherein said computer generated analysis comprises separate analyses for each of said value chain steps and said performance attributes as taught by Englemen et al. One skilled in the art would have been motivated to make the modification for the benefit of improving both specific and broad aspects of the company.

Englemen et al. does not explicitly teach interspersing the performance attribute questions within the groups of questions.

Official Notice is taken that interspersing questions within groups of questions is old and well-known in the art.

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the automated consulting system of Cavanah further with interspersing the performance attribute questions within the groups of questions. One skilled in the art would have been motivated to make the modification for the benefit of convenience since it would lessen the amount of sets of questions that would need to be asked.

Englemen et al., not Cavanah, teaches predetermined weightings of said evaluation
questions are changeable in response to a determination by said industry expert (see
paragraphs [0047] through [0050]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of
invention to modify Cavanah further with predetermined weightings of said evaluation questions
being changeable in response to a determination by said industry expert as taught by Englemen
et al. One skilled in the art would have been motivated to make the modification for the benefit
of better targeting the goals of the company.

Englemen et al., not Cavanah, teaches a computer generated analysis comparing said
responses to said evaluation questions to said weighting of said evaluation category (see
[0049]).

It would have been obvious to one of ordinary skill in the art at the time of invention to
modify Cavanah further with a computer generated analysis comparing said responses to said
evaluation questions to said weighting of said evaluation category as taught by Englemen et al.
One skilled in the art would have been motivated to make the modification for the benefit of
incorporating the relative importance of each function under review at the company.

8.   Regarding claims 14 and 30,

Engelmen et al., not Cavanah teaches wherein said computer generated analysis
comprises a first analysis comparing said responses to said evaluation questions to said
weighting of said evaluation category; and wherein said computer generated analysis further
comprises a second analysis, said second analysis grouping said responses to said evaluation
questions from different categories of said evaluation category into measurement categories
thereby combining said grouped responses into an effectivity result for each measurement

category, said second analysis further comprising recommended solutions based on said

effectivity result (see paragraphs [0047] through [0050]).

It would have been obvious to one of ordinary skill in the art at the time of invention to

modify the automated consulting system of Cavanah further with wherein said computer

generated analysis comprises a first analysis comparing said responses to said evaluation

questions to said weighting of said evaluation category; and wherein said computer generated

analysis further comprises a second analysis, said second analysis grouping said responses to

said evaluation questions from different categories of said evaluation category into

measurement categories thereby combining said grouped responses into an effectivity result for

each measurement category, said second analysis further comprising recommended solutions

based on said effectivity result (see paragraphs [0047] through [0050]). One skilled in the art

would have been motivated to make the modification to accomodate the relative importance of

each function under review at the company and to optimize differentiating requirements (see

[0049] through [0050]).

9.   Claims 2, 9, 18, and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over

Cavanah in view of Englemen et al., further in view of Official Notice.

10.   Regarding claims 2 and 18,

Englemen et al., not Cavanah, teaches wherein said evaluation categories comprise

categories of value chain steps and performance attributes and wherein said evaluation

questions comprise groups of questions organized within each of said value chain steps (see

paragraphs [0047] through [0050]). Examiner notes that "Executive Questions" in the reference

are performance attributes whereas "functions under review" in the reference are the value

chain steps. Englemen et al. further teaches wherein said weighting comprises a weighting determined by said industry expert for each of said value chain steps and said performance attributes; and wherein said computer generated analysis comprises separate analyses for each of said value chain steps and said performance attributes (see paragraphs [0047] through [0050]).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the automated consulting system of Cavanah with said evaluation categories comprising categories of value chain steps and performance attributes and said evaluation questions comprising groups of questions organized within each of said value chain steps; wherein said weighting comprises a weighting determined by said industry expert for each of said value chain steps and said performance attributes; wherein said weighting comprises a weighting determined by said industry expert for each of said value chain steps and said performance attributes; and wherein said computer generated analysis comprises separate analyses for each of said value chain steps and said performance attributes as taught by Englemen et al. One skilled in the art would have been motivated to make the modification for the benefit of improving both specific and broad aspects of the company.

Englemen et al. does not explicitly teach interspersing the performance attribute questions within the groups of questions.

Official Notice is taken that interspersing questions within groups of questions was old and well-known in the art at the time of invention.

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the automated consulting system of Cavanah further with interspersing the performance attribute questions within the groups of questions. One skilled in the art would

have been motivated to make the modification for the benefit of convenience since it would

lessen the amount of sets of questions that would need to be asked.

11.   Regarding claims 9 and 25,

        Cavanah and Englemen et al. do not teach collecting said responses to said evaluation

questions thereby benchmarking said responses with responses to a same set of evaluation

questions from another industry expert.

        Official Notice is taken that using answers to questions to establish benchmarking

information was old and well-known in the art at the time of invention.

        It would have been obvious to one of ordinary skill in the art at the time of invention to

modify the automated consulting system taught by Cavanah further with using collecting

responses to said evaluation questions thereby benchmarking said responses with responses to

a same set of evaluation questions from another industry expert. One skilled in the art would

have been motivated to make the modification for the benefit of establishing standard practices.

12.   Claims 3 and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Cavanah

in view of Englemen et al., further in view of Official Notice, further in view of Peters et al. (US

Patent Application Pub. No. US-2003/0088489 A1).

13.   Regarding claims 3 and 19,

        Cavanah and Englemen et al. do not teach said value chain steps comprising profile

assessment, asset allocation, asset selection, order generation, and reporting and monitoring.

        Peters et al. teaches that portfolio management comprises profile assessment, asset

allocation, asset selection, order generation, and reporting and monitoring.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of

invention to modify the automated consulting system of Cavanah further with value chains steps

comprising profile assessment, asset allocation, asset selection, order generation, and reporting

and monitoring as taught by Peters et al. One skilled in the art would have been motivated to

make the modification because profile assessment, asset allocation, asset selection, order

generation, and reporting and monitoring are potential areas of improvement in the portfolio

management process.

14.   Claims 4 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Cavanah

in view of Englemen et al., further in view of Official Notice, further in view of De Goeij (US

Patent Application Pub. No. 2003/0110070 A1).

15.   Regarding claims 4 and 20,

Cavanah and Englemen et al. do not explicitly teach wherein said performance attributes

comprise automation, scalability, and outsourcing and insourcing.

De Goeij teaches considering automation, scalability, outsourcing, and insourcing when

improving an organization (see paragraphs [0001], [0005], and [0049]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of

invention to modify the automated consulting system taught by Cavanah further with

performance attributes comprising automation, scalability, and outsourcing and insourcing as

taught by De Goeij. One skilled in the art would have been motivated to make the modification

because automation, scalability, and outsourcing and insourcing are general areas of potential

improvement for an organization. Thus, the attributes would be appropriate to consider in

conducting a horizontal improvement analysis of a company.

16.   Claims 7 and 23 rejected under 35 U.S.C. 103(a) as being unpatentable over Cavanah

in view of Englemen et al, further in view of BusinessWire ("Pacific Softworks Announces

Investment and Strategic Alliance with Redflag Inc.").

17.   Regarding claims 7 and 23,

        Cavanah teaches computer-generated separate analyses but does not explicitly teach

each analysis comprising an automatic graphical flag identifying a level of improvement

potential.

        BusinessWire teaches computer-generated separate analyses, each analysis

comprising an automatic graphical flag identifying a level of improvement potential (see page 2

paragraph 6).

        Therefore, it would have been obvious to one of ordinary skill in the art at the time of

invention to modify the automated consulting system taught by Cavanah further with automatic

graphical flags identifying levels of improvement potentials. One skilled in the art would have

been motivated to make the modification for the benefit of convenience.

18.   Claims 15 and 31 rejected under 35 U.S.C. 103(a) as being unpatentable over Cavanah

in view of Englemen et al., further in view of Official Notice, further in view of BusinessWire.

19.   Regarding claims 15 and 31,

        BusinessWire teaches computer-generated separate analyses, each analysis

comprising an automatic graphical flag identifying a level of improvement potential (see page 2

paragraph 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of

invention to modify the automated consulting system taught by Cavanah further with automatic

graphical flags identifying levels of improvement potentials. One skilled in the art would have

been motivated to make the modification for the benefit of convenience.

20.   Claims 8 and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Cavanah

in view of Englemen et al., further in view of Lostis et al. (US Patent Application Pub. No.

2002/0026429 A1).

21.   Regarding claims 8 and 24,

         Cavanah and Englemen et al. do not explicitly teach a value tree analysis grouping said

responses to said evaluation questions from different categories into measurement categories

thereby combining said grouped responses into an effectivity result for each measurement

category, said value tree analysis further comprising recommended solutions based on said

effectivity result.

         Lostis et al. teaches multi-attribute decision analysis tools for value trees. These tools

perform a value tree analysis grouping different categories into measurement categories to

provide an effectiveness result (see [0165]).

         Therefore, it would have been obvious to one of ordinary skill in the art at the time of

invention to modify the automated consulting system of Cavanah further with a value tree

analysis grouping said responses to said evaluation questions from different categories into

measurement categories thereby combining said grouped responses into an effectivity result for

each measurement category, said value tree analysis further comprising recommended

solutions based on said effectivity result. One skilled in the art would have been motivated to make the modification for the benefit of identifying the strategy most likely to reach a goal.

22.   Claims 12, 13, 16, 28, 29, and 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Cavanah in view of Englemen et al., further in view of Official Notice, further in view of Peters et al., further in view of De Goeij.

23.   Regarding claims 12 and 28,

Cavanah and Englemen et al. do not teach said value chain steps comprising profile assessment, asset allocation, asset selection, order generation, and reporting and monitoring.

Peters et al. teaches that portfolio management comprises profile assessment, asset allocation, asset selection, order generation, and reporting and monitoring.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the automated consulting system of Cavanah further with value chains steps comprising profile assessment, asset allocation, asset selection, order generation, and reporting and monitoring. One skilled in the art would have been motivated to make the modification because profile assessment, asset allocation, asset selection, order generation, and reporting and monitoring are potential areas of improvement in the portfolio management process.

Cavanah and Englemen et al do not explicitly teach wherein said performance attributes comprise automation, scalability, and outsourcing and insourcing.

De Goeij teaches considering automation, scalability, outsourcing, and insourcing when improving an organization (see paragraphs [0001], [0005], and [0049]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the automated consulting system taught by Cavanah further with

performance attributes comprising automation, scalability, and outsourcing and insourcing. One skilled in the art would have been motivated to make the modification because automation, scalability, and outsourcing and insourcing are general areas of potential improvement for an organization. Thus, the attributes would be appropriate to consider in conducting a horizontal improvement analysis of a company.

24.   Regarding claims 13 and 29,

Cavanah and Englemen et al. do not teach collecting said responses to said evaluation questions thereby benchmarking said responses with responses to a same set of evaluation questions from another industry expert.

Official Notice is taken that using answers to questions to establish benchmarking information is old and well-known in the art. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the automated consulting system taught by Cavanah further with using collecting responses to said evaluation questions thereby benchmarking said responses with responses to a same set of evaluation questions from another industry expert. One skilled in the art would have been motivated to make the modification for the benefit of establishing standard practices.

25.   Regarding claims 16 and 32,

Cavanah and Englemen et al. do not teach wherein said evaluation questions comprise questions directed to profile assessment, asset allocation, asset selection, order generation, reporting and monitoring, automatization, scalability, and outsourcing and insourcing.

Peters et al. teaches that portfolio management comprises profile assessment, asset allocation, asset selection, order generation, and reporting and monitoring and De Goeij teaches

considering automation, scalability, outsourcing, and insourcing when improving an organization (see paragraphs [0001], [0005], and [0049]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the automated consulting system of Cavanah further with wherein said evaluation questions comprise questions directed to profile assessment, asset allocation, asset selection, order generation, reporting and monitoring, automatization, scalability, and outsourcing and insourcing as taught by Peters et al and De Goeij.

One skilled in the art would have been motivated to make the modification because profile assessment, asset allocation, asset selection, order generation, and reporting and monitoring are potential areas of improvement in the portfolio management process.

Cavanah teaches collecting responses from said industry expert to benchmarking questions, wherein said benchmarking questions cluster and segment a company of said industry expert (see page 2 paragraph 2).

The references above do not explicitly teach collecting said responses to said evaluation questions thereby benchmarking said responses with responses to a same set of evaluation questions from another industry expert.

Official Notice is taken that using answers to questions to establish benchmarking information was old and well-known in the art at the time of invention.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the automated consulting system taught by Cavanah further with using collecting responses to said evaluation questions thereby benchmarking said responses with responses to a same set of evaluation questions from another industry expert. One skilled in the art would have been motivated to make the modification for the benefit of establishing standard practices.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC WONG whose telephone number is (571)270-3405. The examiner can normally be reached on Monday-Friday 9:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693

Eric Wong
Examiner
Art Unit 3693

March 22, 2008